

**REMARKS**

**I. Status of the Claims**

Claims 80, 82, 83, 86-93, 97-100, 104-125, 134, 135, and 139-186 are pending in this application, with claims 80, 82, 86-93, 97-100, 104-125, 134, 135, 139-149 and 167-186 under consideration and rejected. No claim has been amended herein.

**II. Rejections under 35 U.S.C. § 103(a)**

The Examiner maintains the rejection of claims 80, 82, 86-93, 97-100, 104-149, and 167-186 under 35 U.S.C § 103(a) over U.S. Patent No. 5,843,417 to Hanna et al. ("Hanna") in view of U.S. Patent No. 5,902,592 to Bara et al. ("Bara"). *Office Action* at pp. 4-7. In addition, in response to Applicants response filed October 14, 2010, the Examiner contends that:

Applicant's argument has been fully considered but not found persuasive. Hanna et al. teach that the cosmetic composition comprises 0.1 to 10% propylene glycol, a carbon 3 polyol. One would have been motivated to adjust the concentration of propylene glycol to arrive at the instant concentration through routine optimization in order to achieve the proper moisturizing effect desired. Therefore, Hanna et al. suggest[s] the use of the instantly claimed first polyol at the instantly claimed concentration. Bara et al. teach the use of both propylene glycol and 5% polyethylene glycol, a carbon 4 polyol. One would have been motivated to combine the teachings of Hanna et al. with Bara et al. in order to adjust the feel and behavior of the cosmetic composition on the skin it is being applied to.

*Id.* at 7. Applicants disagree and traverse these rejections for the reasons of record and for the additional reasons below.

In *KSR*, the Supreme Court noted that, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727,

1741 (2007). *KSR* does not lift the Office's burden of establishing a *prima facie* case of obviousness, and as subsequently held by the Federal Circuit: a proper support for a Section 103 rejection in the chemical arts requires the prior art to supply a reason or motivation to make the claimed compositions. See *Aventis Pharma. Deutschland GmbH v. Lupin Ltd.*, 84 USPQ 2d 1197, 1204 (Fed. Cir. 2007) (emphasis added) (citing *Takeda*, 83 USPQ2d at 1174).

Here, with respect to the rejection over the combination of *Hanna* and *Bara*, Applicants submit that the Examiner points to no such rationale in either of the references that would have motivated one skilled in the art to combine specific elements found in the prior art to render the present claims obvious.

Along these lines, the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 415-419, 82 U.S.P.Q.2d 1385, 1395-97 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reasons why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. See *id.* at 418, 82 U.S.P.Q.2d at 1396.

Precedent requires that the Office look at various teachings "in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed," especially given that "claimed discoveries almost of necessity will be

combinations of what, in some sense, is already known.” *KSR*, 550 U.S. at 418, 82

U.S.P.Q.2d at 1396.

Applicants respectfully submit that the Examiner has failed to meet this burden and consequently has not, and cannot make, a *prima facie* case of obviousness.

*Hanna* is directed to a waterproof, long wear cosmetic products having transfer resistant properties where the product is an oil-in-water emulsion based upon a C<sub>10</sub>-C<sub>14</sub> linear or branched hydrocarbon based oil. See *Hanna*, abstract. As admitted by the Examiner, *Hanna* does not teach the claimed volatile silicone oils and is silent with respect to the claimed second water miscible polyol. *Office Action* at 6. Moreover, *Hanna* exemplifies the oil surfactants dimethicone copolyol, laurylmethicone copolyol, glyceryl stearate, cetyl dimethicone copolyol, polyglyceryl-4-isostearate, and hexyl laurate, but neither of which fall within the carbon atom ranges claimed for the first and second water miscible polyol. *Id.* at col. 5, lines 3-6. Thus, *Hanna* also provides no specific guidance that would have led one of ordinary skill in the art to select the claimed first polyol.

Accordingly, *Hanna* is absent the necessary teachings of the claimed volatile oils and second water miscible polyol, and further lacks the required guidance to alter or substitute the exemplified oil surfactants to arrive at the claimed first water miscible polyol. The fact that *Hanna* is silent with respect to the above elements leaves the skilled artisan with, at best, a general representation of cosmetic compositions having oils. To this end, there is no teaching or suggestion that would have motivated a person of ordinary skill in the art to select the specific combination of oils as claimed in the present application. *Hanna's* general teachings presents a fatal deficiency in the

Examiner's allegations, that is, the "prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful." *In re Marek Z. Kubin And Raymond G. Goodwin* (Feb. Cir. April, 2009), citing *In re O'Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988). Accordingly, *Bara* must cure the fatal flaws of *Hanna* and justify the Examiner's assertion that the present claims are obvious. *Bara* does not, for the reasons that follow.

*Bara* teaches the combination of cyclopentadimethylsiloxane and cyclohexadimethylsiloxane in a cosmetic composition formulated as an oil-in-water emulsion. See *Bara*, abstract. However, *Bara* in no way provides any motivation to combine other elements to arrive at the present claims. *Bara* only exemplifies non-silicone oils in the form of fatty substances, which can be esters of lanolic acid, oleic acid, lauric acid, stearic acid, or myristic acid. *Bara* at col. 3, lines 50-53. There is nothing in *Bara* that teaches or suggests the polyols recited in the independent claims, nor is there anything that would indicate to one of ordinary skill in the art that incorporation of polyols, much less those recited in the independent claims, would produce a successful result. Accordingly, like *Hanna*, *Bara* provides no indication of which parameters are critical and leaves the skilled artisan with no direction as to what additional oils, much less the combination of the claimed oils; the combination of which is likely to be successful.

### **III. Declaration of Pascal ARNAUD**

Applicants submit that by its very nature, an obviousness rejection is based on the assumption that certain compositions will exhibit similar properties. However, as shown in the Declaration under 37 C.F.R. § 1.132 of Pascal ARNAUD ("Declaration")

submitted herewith, this is not the case for the combinations and modifications suggested by the Examiner. Rather, the Declaration establishes unpredictability, demonstrating that there is no presumption that the combination of the general oils described in *Hanna* and *Bara* would result in similar properties.

In the Declaration, inventive Composition 1 containing, among other ingredients, cyclohexadimethylsiloxane, cyclopentadimethylsiloxane, and isododecane was compared with a comparative Composition A (related to *Hanna*, i.e., does not contain the claimed second volatile silicone oil), a comparative Composition B (related to *Hanna*, i.e, does not contain the claimed first and second volatile silicone oils), and a comparative Composition C (related to *Bara*, i.e., does not contain the claimed volatile hydrocarbon-based oil.)

The results of the comparison demonstrate that inventive Composition 1 containing at least one volatile hydrocarbon-based oil, at least one first volatile silicone oil with a flash point of greater than or equal to 55 °C and less than or equal to 80 °C, and at least one second volatile silicone oil with a flash point of greater than or equal to 80 °C and less than or equal to 95 °C led to more rapid and easier application with improved glide when compared to the comparative compositions A-C, which are representative of the prior art relied upon by the Examiner. In the comparison,

0.10 g of each composition was applied on half of the face of each person on a panel consisting of four people. Each person noted a more rapid and easier application and better gliding effect with Composition 1 (inventive). In contrast, comparative composition A exhibited a more creamy effect while comparative compositions B and C were more thick to apply to the face.

Declaration at 7. As such, these results provide evidence that nothing in the general disclosures of *Hanna* or *Barra*, or combination thereof, would have led one skilled in the art to pick and choose components from the prior art with any reasonable expectation that combining the choices would make any difference in result.

Accordingly, Applicants submit that this evidence demonstrates that such a *prima facie* case was never established by the Examiner. For the reasons of record and the forgoing remarks, Applicants submit that the § 103 rejection be withdrawn.

#### IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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